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7590 04/20/2004
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| EXAMINER |
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| ART UNIT | PAPER NUMBER |
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2122

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/768,482

Applicant(s)

WIGGINS ET AL.

Examiner

Ted T. Vo

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-20 is/are pending in the application.
- 4a) Of the above claim(s) 19-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 19 and 20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to Applicants' amendment filed on 1/27/2004, where
Claims 1 and 3 are amended. Claim 2 is canceled. Claims 4-20 are newly added.
Claims 19-20 are withdrawn from consideration as being directed to a non-elected invention.
Claims 1, 3-20 remain pending in the application.

Response to Arguments

2. Applicants' arguments given in their Remarks (pages 9-10) to the rejection of Claims 1 and 3 under 35 USC 102(a) which merely argue for the newly added limitations of Claim 1, "means for migrating" including a "console module" and "self-extracting auto-migration software package" (re: remarks: page 9) have been fully considered but are moot in view of the new ground(s) of rejection.

Applicants' amendment necessitates a new ground of rejection. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Election/Restrictions

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1, 3-18 are drawn to a system and a method comprising means for migrating an upgrading application file in a network, classified in class 717, subclass 173.
 - II. Claim 19 is drawn to a method for creating an Application information file for the purpose of generating an update for an older version of a program under development, classified in class 717, subclass 110.

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- III. Claim 20 is drawn to a method for gathering installed application using Application information Files for the purpose of getting files in order to store into the Application information Files, classified in class 717, subclass 169.

The inventions are distinct, each from the other because of the following reasons:

Inventions of groups II, and III are unrelated to the current examining group I. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case, the invention I has a separate utility for migrating that is different from the inventions II and III.

Newly added Claims 19-20 are directed to inventions that are independent or distinct from the invention originally claimed for the following reasons as analyzed above.

Since applicant has received an action on the merits for the originally presented invention, this invention, Claims 1, 3-18, has been constructively elected by original presentation for prosecution on the merits. Accordingly, newly added Claim 19, and Claim 20 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

5. Claim 3 is rejected under 35 U.S.C. 102(a) as being anticipated by Inside the Internet, "Create self-extracting ZIP files with WinZip 6.3" ProQuest Computing, 5-2000.

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Given the broadest reasonable interpretation of followed claims in light of the specification:

As per claim 3:

Inside the Internet discloses:

(A) loading a Personality Package, said Personality Package further comprising setting, preferences applications, data fields (see page 14, Figure E, a WinZip self-extractor that contains files/applications, is figured out to be extracted);

(B) executing said Personality Package (see page 12, right column, last paragraph, self-extracting ZIP file is an executable program);

(C) getting a file; (D) copying said file; and determining whether migration of additional files is required and if additional files are required returning to said getting a file step; (see popup window in page 13, Figure C, it shows that files are selected and copied into the open area, based on buttons such as NEW, OPEN, ADD, CHECKOUT, etc.).

(E) getting a registry; (F) copying said registry; (see popup window in page 13, Figure C, it shows features such as "file", "action", "option" all the basic features of window operating, where these features allow a user to search through a registry to copy/select it);

(G) getting application version specifics, and testing to determine if destination application version match and generating an error if said destination application versions do not match; and (H) updating links (See page 13, right column, last paragraph, WinZip has ability to test to make sure file functionality before sending it to an intended recipient).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A person shall be entitled to a patent unless –

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious

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at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1, 4-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kahani, WWWCopy™ Version 1.1 (a description of a download version appeared in the Internet, July 1997), in view of Inside the Internet, "Create self-extracting ZIP files with WinZip 6.3", ProQuest Computing, 5-2000.

Given the broadest reasonable interpretation of followed claims in light of the specification.

As per claim 1:

Regarding claim limitation: "A system for describing and extracting application information, comprising:

(A) a first computer system, said first computer system further comprising: (1) an input device; (2) a display device; and (3) a processing unit, said processing unit further comprising: (a) a processor; (b) memory; and (c) a long-term storage device; (re: Kahani: inherent in a computer, at given URL, e.g. see figure on p.2, at "http://130.130.88.201/...")

(B) a second computer system, said second computer system further comprising: (1) an input device; (2) a display device; and (3) a processing unit, said processing unit further comprising: (a) a processor; (b) memory; and (c) a long-term storage device; (re: Kahani: inherent in a computer, at local site running the display window on p.2)

(C) an application program resident on said long term storage device of said processing unit of said first computer system (re: Kahani: inherent in a file directory in a computer, memory of the computer at given URL so that "shareware" can be downloaded/distributed); and

(D) a means for migrating said application program from said first computer to said second computer, (re: Kahani: inherent in a modem installed in a computer).

Kahani describes a shareware that covers above limitations, wherein said means for migrating further comprises: (1) an application interface file, in an INI format, (see page 1, Table of contents, '.ini file format') wherein said application interface file further comprises a tag that identifies a feature of said

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application program (see page 5, section 3.4, [PREF], FRAME, IMG, in .ini file format); (2) a communication channel between said first computer system and said second computer system (see page 2, 'http://... 'shown in a popup window). Furthermore, Kahani discusses a 'WWWCopY shareware' (application program) that is stored in a first computer, provided (downloaded) to second computer. A WWWCopY is packed in a WWWCopY.zip and installed in the second computer (see page 3, section 3.1, 'How to install WWWCopY), where the WWWCopY.zip includes file WWWCopY.ini in INI format, and where the format includes tags such as PREF tag, or tags linked to HTML such as FRAME, IMG, etc. (see page 5, section 3.4). When the WWWCopY is run in combined with a URL page (page 1, section 1, 'What is WWWCopY'), tag preferences in the INI format file will be described in a popup window (Dialog window of page 4). The popup window shows containing information of the WWWCopY shareware.

Kahani does not expressly show:

"(3) a console module in communication with said applicant interface file; and

(4) a self-extracting auto-migration package built by said console module"

Inside the Internet reference shows a WinZip 6.3 that includes a Drag and Drop dialog box (re: Inside the Internet; Page 14, Figure D) used to build a WinZip self-extractor package (re: Inside the Internet; Page 14, Figure E) to send to an intended recipient (re: Inside the Internet; see page 13, right column, last paragraph) for covering the limitation of (3) and (4) above.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention was made to combine the teaching of Kahani which teaches sending out a personal package that includes a INI file in the ZIP file, and the teaching of Inside the Internet for creating a self-extractor included with the features of migrating and extracting files.

Doing so would allow a user to send or receive files automatically in a compact manner.

Regarding further limitations of Claims 4-17:

Inside the Internet reference discloses the further features of ***"(3) a console module in communication with said applicant interface file; and (4) a self-extracting auto-migration package***

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built by said console module", as address above, where Inside the Internet further covers the extended features of limitations of (3) and (4) that limit within the claim limitations of Claims 4-17:

As per Claim 4: Inside the Internet further shows the WinZip 6.3 with ADD (re: Inside the Internet, Figure B, page 13) or Drag and Drop (re: Inside the Internet, Figure D, page 14), and WinZip Self-Extractor Personal Edition (re: Inside the Internet, Figure E, page 14) for creating self-extractor packages.

As per Claim 5: Inside the Internet further shows the WinZip 6.3 which is adaptable to a standard Window like Window 95, where the WinZip like the one in Figure C (page 13) can edit a file using "FILE" adaptable by the Window 95.

As per Claim 6: With regard to limitation of Claim 6, see all the buttons shown in the Figure C, to provide a user who creates a package to determine the setting and file types.

As per Claim 7: With regard to limitation of Claim 7, see page 12, right column, last paragraph; Self-Extracting Zip file is an executable file.

As per Claim 8: With regard to limitation of Claim 8, see page 12, right column, last paragraph, "recipient", who receives the Self-Extracting Zip file.

As per Claim 9: With regard to limitation of Claim 9, see page 14, right column, first paragraph, "attachment to your email".

As per Claim 10: With regard to limitation of Claim 10, see page 12, Figure A "FILE", or button "OPEN", where "FILE" is known as allowing a user to edit a file.

As per Claim 11: With regard to limitation of Claim 11, see page 13, Figure B, button "Password".

As per Claim 12: With regard to limitation of Claim 12, see page 12, right column, paragraph "Why Zip Your File?" and "compression files to save space".

As per Claim 13: With regard to limitation of Claim 13, see page 12, Figure C, all Buttons (such as EXTRACT", has means of operating system conversion.

As per Claim 14: With regard to limitation of Claim 14, see page 13, Figure C, the features shown in the bottom line of the WinZip such as byte selected, size of a file.

As per Claim 15: With regard to limitation of Claim 15, see page 13, Figure C, line that describes in text such as name, date, time etc., of a file in the WinZip.

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As per Claim 16: With regard to limitation of Claim 16, see page 13, Figure C, button NEW or ADD, where these buttons allow a file to be duplicated and migrated in the Self-Extractor.

As per Claim 17: With regard to limitation of Claim 17, see page 13, Figure C, button ADD or EXTRACT, where the EXTRACT is known as unattended installation of the files.

Regarding further limitations of Claim 18:

As per Claim 18: Inside the Internet reference does not express show Self-extracting auto-migration package further comprises "*user-defined profiles*"

Official notice is taken that User-defined profiles are well-known in the art where the feature of "user-defined profiles" is used commonly for retaining user's data/information set by a user and maintained by Windows operating system for password protection and network connection. Figure B suggests "user-defined profiles" by showing button Password.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time of invention was made to include "User-defined Profiles" because it is used by a user for retaining user's data/information which is necessary for establishing a connection with a network.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ted T. Vo whose telephone number is (703) 308-9049. The examiner can normally be reached on Monday-Friday from 8:00 AM to 5:30 PM ET. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Dam, can be reached on (703) 305-4552.

The fax phone numbers:

(703) 872-9306 (for formal communication intended for entry);

(703) 746-5429 (for informal or draft communication, please label "PROPOSED" or "DRAFT").

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

TTV
April 16, 2004



TUAN DAM
SUPERVISORY PATENT EXAMINER